

REMARKS

Applicants thank Examiner Wang for the courtesies extended in the telephone interview with the undersigned Applicants' representative on May 10, 2007. During the interview, the amendments as set forth above were discussed. The Examiner indicated that those amendments would be a "positive move."

I. Status of Claims

Claims 1, 3, 18, 25, 28, 38, 39, 43-58 and 71 are pending in this application. In the present Amendment, claim 70 has been canceled without disclaimer and prejudice. Claims 1, 57, 58, and 71 have been amended. Support for the amendments can be found in the originally-filed specification. Applicants have not introduced any new matter by the amendment, nor does the amendment raise new issues or necessitate the undertaking of any additional search of the art by the Office.

II. Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner rejects claim 71 under 35 U.S.C. § 112, first paragraph. Final Office Action, page 2. Specifically, the Examiner alleges that the phrase "R10 and R11 are each chosen from piperidyl groups and morpholinyl groups" in claim 71¹ "lack[s] support from the application as originally filed." *Id.*

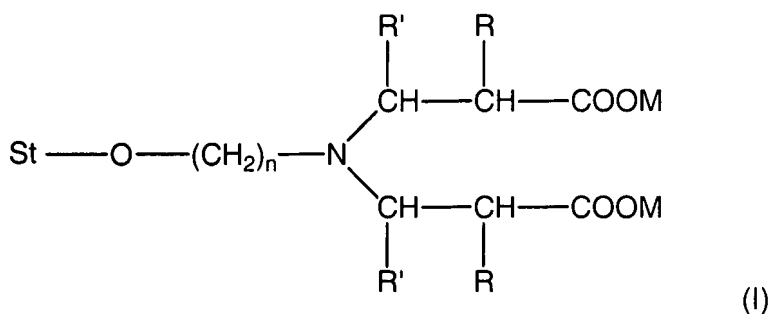
¹ The Examiner has apparently made a typographic error in stating "claim 70 recites . . ." (final Office Action, page 2), as the phrase quoted by the Examiner is not in claim 70, but in claim 71. Applicants respectfully request clarification of the record.

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions and listings of claims in the application:

1. (Currently amended) A cosmetic composition, comprising in a cosmetically acceptable medium:

a) at least one amphoteric starch chosen from the compounds of formula (I):



wherein:

St-O is a starch moiety,

R, which may be identical or different, are each chosen from a hydrogen atom and a methyl group,

R', which may be identical or different, are each chosen from a hydrogen atom, and a methyl group,

n is chosen from integers ranging from 2 to 3,

M, which may be identical or different, are each chosen from a hydrogen atom, an alkali metal, an alkaline-earth metal, NH₄, quaternary ammonium compounds, and organic amines; and

Claim 71 has been amended as shown above. Support for the amendment in claim 71 can be found in the originally-filed specification, page 30, lines 3-4. Therefore, Applicants respectfully request this rejection be withdrawn.

II. Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner also rejects claims 70 and 71 under 35 U.S.C. § 112, second paragraph. Final Office Action, page 2. Specifically, the Examiner states that claims 70 and 71 are indefinite because, in formulae (XVIII) and (XIX), “the methylene carbon next to R12 is saturated.” *Id.* The Examiner further states that the limitation in claim 71, i.e., “R10 and R11 are each chosen from piperidyl groups and morpholinyl groups” does not have sufficient antecedent basis. *Id.* at 3.

Applicants amended the formulae (XVIII) and (XIX) as shown in, for example, claims 1 and 57 above. Support for the amendment can be found in the originally-filed specification, page 29, lines 3-6. In addition, claim 70 has been canceled and claim 71 has been amended as discussed above. Therefore, Applicants respectfully request this rejection be withdrawn.

III. Provisional Obviousness-Type Double Patenting Rejection

The Examiner provisionally rejects claims 1, 3, 18, 25, 28, 38, 39, and 43-58 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 12, 16, 20, and 21 of co-pending Application No. 09/759,530 (“the co-pending '530 application”). Final Office Action, page 3. Applicants respectfully disagree.

However, solely to advance the prosecution of the present application, Applicants have concurrently filed a Terminal Disclaimer to obviate this rejection. Therefore, Applicants respectfully request this rejection be withdrawn.

III. Rejections under 35 U.S.C. § 103

A. Claims 1, 3, 18, 25, 28, 38, 39, and 43-58

The Examiner has maintained the rejection of claims 1, 3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103 over U.S. Patent No. 5,482,704 to Sweger et al. ("Sweger") in view of U.S. Patent No. 6,010,689 to Matsumoto et al. ("Matsumoto") and U.S. Patent No. 5,876,705 to Uchiyama et al. ("Uchiyama") or over U.S. Patent No. 4,954,335 to Janchipraponvej ("Janchipraponvej") in view of Sweger, Uchiyama, and U.S. Patent No. 6,210,689 to Martino et al. ("Martino") for the reasons of record. Final Office Action, pages 4-7. Specifically, the Examiner admits that "Sweger does not teach expressly [certain] ingredients in the hair composition, such as [the] conditioning agent behenyltrimethylammonium, or [the] anionic surfactant alkyl ether sulfate." *Id.* at 4. The Examiner also admits Janchipraponvej does not teach "modified starch and anionic surfactants." *Id.* at 6. To remedy these deficiencies, the Examiner relies on the secondary references and alleges that "Sweger teaches the modified starch herein are known to be useful in hair care products and the other agents herein are well-known hair care product ingredients." *Id.* at 8. Applicants respectfully traverse these rejections for the reasons of record and the following additional reasons.

In order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation,

either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The Supreme Court, in the recent *KSR* case, recognized that a showing of “teaching, suggestion, or motivation” could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR*, slip op. at 14.

In addition, the Supreme Court mandates that “[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that **“in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”** (Emphasis in original).

Here, the Examiner has failed to provide any explicit reason why one of ordinary skill in the art would pick and choose the cationic conditioner from all types of well-known hair care product ingredients, let alone the specific cationic conditioners as

recited in, for example, the currently amended claim 1. Therefore, the Examiner has not established a *prima facie* case of obviousness. Accordingly, this rejection is improper.

The Examiner also alleges that the Declaration under 37 C.F.R. § 1.132 by MAHE filed September 13, 2006, “fails to rebut the *prima facie* case of obviousness,” because allegedly “the claimed invention is not commensurate in scope with the data presented in the declaration.” Final Office Action, page 9. Applicants respectfully disagree.

While unexpected results must be “commensurate in scope with the claimed invention,” (M.P.E.P. § 716.02(d)), “commensurate in scope” does not mean “*identical* in scope.” Any other conclusion defies logic and common sense, as it would be impossible to test every single possible combination of elements that could be incorporated into a claim *comprising* various ingredients. Rather, the M.P.E.P. provides a more logical course of action for determining the nonobviousness of claimed subject matter constituting a large genus, such as the present claims: “[t]he nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one skilled in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof.” *Id.* at § 716.02(d) I.

Indeed, the data for three species of cationic conditioners presented in Mme. MAHE’s September 13, 2005, Declaration establishes a clear trend that would allow one skilled in the art to extend the probative value to the entire genus of cationic conditioners claimed herein. And that trend, as admitted by the Examiner in the November 30, 2005, Office Action, indisputably establishes an “unexpected benefit.”

Moreover, as Applicants have discussed in detail on the record, the alleged combination of Janchipraponvej with Sweger by the Examiner would destroy the intended purpose of Janchipraponvej, which is to provide a **clear** composition. Indeed, incorporating the starch of Sweger into the composition of Janchipraponvej would destroy the composition's lauded clarity. See Applicants' November 10, 2004, Reply After Final; Applicants' May 24, 2004, Reply to Office Action; Applicants' December 1, 2003, Request for Reconsideration; and Mme. MAHE's November 24, 2003, Rule 1.132 Declaration. The destruction of the composition's clarity defeats an allegation of obviousness since it is known that "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01 V.

Therefore, Applicants respectfully request these rejections be withdrawn.

B. Claims 70 and 71

The Examiner has also rejected claims 70 and 71 under 35 U.S.C. § 103 over Sweger, in view of Matsumoto and Uchiyama, and in further view of U.S. Patent No. 3,912,808 to Sokol ("Sokol") or over Janchipraponvej in view of Sweger, Matsumoto and Uchiyama, and in further view of Sokol for the reasons of record. Final Office Action, pages 7-8. Applicants respectfully traverse these rejections for the reasons of record and the following additional reasons.

As noted, claim 70 has been canceled, rendering the rejections against claim 70 moot.

In addition, for the same reasons as set forth above in subsection A, the Examiner has failed to establish a prima facie case of obviousness against claim 71.

Therefore, Applicants respectfully request the rejections of claims 70 and 71 be withdrawn.

V. Conclusion

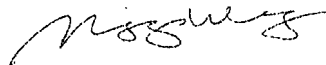
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: June 15, 2007

By: 

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